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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,729	02/06/2001	Glenn R. Toothman III	00-40292 CIP	6075

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EXAMINER

LI, ZHUO H

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 06/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/777,729

Applicant(s)

TOOTHMAN ET AL.

Examiner

Zhuo H Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. According to the amendment filed on May 27, 2003 (Paper no. 9) the argument of rejection pursuant to 35 U.S.C. 102(b) as being anticipated by Colnot is persuasive, thereby the rejection is withdrawn. However, the rejection of 35 U.S.C. 102(b)/103(a) by Want is maintained, and the previous Office action has been modified in response to the amendment filed on May 27, 2003 (Paper no. 9).

### ***Claim Objections***

2. Claims 1, 16 and 41 are objected to because of the following informalities:

Regarding claims 1, 16 and 41, the term “substantially immovable” should be further clarified because the term does not clearly define how the equipment is constructed with an object in order to make substantially immovable.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-4, 6-7, 10-19, 21-31 and 33-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Want et al. (US PAT. 6,008,727 hereinafter Want).

Regarding claim 1, Want discloses a system (10, figure 1) for providing instructions for substantially immovable equipment (50, figure 1) at an inaccessible location (col. 6 line 37 through col. 7 line 10) comprising a permanently spatially fixed electronic tags, i.e., memory device affixed to the various object, i.e., equipment, the instructions residing on the memory device (col. 6 line 59 through col. 7 line 10 and col. 1 lines 22-29), and a portable memory reading device (120, figure 2), separate from the memory device, that retrieves the instructions from the memory device and communicates the instructions to a user of said portable memory reading device (figure 2 and col. 2 lines 21-27, col. 10 line 60 through col. 11 line 3 and col. 11 line 63 through col. 12 line 15).

Regarding claims 2-3, Want discloses the system wherein the memory device comprises a contact memory device and programmable read only memory device (col. 1 lines 22-29).

Regarding claim 4, Want discloses the system wherein the memory device is permanently affixed to the equipment (col. 6 line 59 through col. 7 line 2).

Regarding claims 6-7, Want discloses the system wherein the information resides on the memory device in extensible markup language format (col. 7 lines 38-48 and col. 9 lines 22-44) and hypertext markup language format (col. 10 lines 19-35).

Regarding claim 10, Want discloses the system further comprising a database wherein the information on the memory device is replicated and wherein the memory device is uniquely associated with an identifying code (col. 9 lines 22- 49).

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Regarding claim 11, Want discloses the system wherein the replicated information may be accessed upon receipt of the identifying code by the database (col. 9 lines 22- 53).

Regarding claims 12-13, Want discloses the system wherein the replicated information is accessed through an Internet and a telephone network (col. 13 lines 9-27 and col. 14 lines 18-44).

Regarding claim 14, Want discloses the database is communicatively connected to the memory device (col. 9 lines 22-44).

Regarding claim 15, Want discloses the system wherein the replicated information may be revised at the database, and wherein the revised replicated information may be communicated from the database to the memory device via the communicative connection (col. 8 lines 56-57 and col. 9 lines 1-21).

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 17-18, the limitations of the claims are rejected as the same reasons set forth in claims 2-3.

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 21-22, the limitations of the claims are rejected as the same reasons set forth in claims 6-7.

Regarding claim 23, the limitations of the claim are rejected as the same reasons set forth in claim 10.

Regarding claim 24, the limitations of the claim are rejected as the same reasons set forth in claim 11.

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Regarding claim 25-26, the limitations of the claims are rejected as the same reasons set forth in claims 12-13.

Regarding claim 27, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 28, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 29, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 30-31, the limitations of the claims are rejected as the same reasons set forth in claims 2-3.

Regarding claim 33-34, the limitations of the claims are rejected as the same reasons set forth in claims 6-7.

Regarding claim 35, the limitations of the claim are rejected as the same reasons set forth in claim 10.

Regarding claim 36, the limitations of the claim are rejected as the same reasons set forth in claim 11.

Regarding claims 37-38, the limitations of the claims are rejected as the same reasons set forth in claims 12-13.

Regarding claim 39, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 40, the limitations of the claim are rejected as the same reasons set forth in claim 15.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5, 8-9, 20, 32 and 41-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al. (US PAT. 6,008,727 hereinafter Want).

Regarding claim 5, the difference between Want and the claims is the claims specifically recite the memory device comprises a weather resistant memory device. However, having a weather resistant memory device does not have a disclosed purpose nor is this weather memory disclosed to overcome any deficiencies in the prior art. As such, the memory device may have been of any resistant. In addition, since Want discloses the electronic tags (i.e., memory device) can be attached permanently or temporarily to various objects, such as paper document, walls,

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floors and furniture (col. 6 line 59 through col. 7 line 10). Accordingly, it would be an obvious matter of design choice to utilize the memory device of Want wherein the memory device comprising a weather resistant memory device, because it prevents the memory device resisting damage from ambient weather conditions.

Regarding claims 8-9, Want teaches the electronic tags (i.e., memory device) can be attached permanently or temporarily to various objects, such as paper document, walls, floors and furniture (col. 6 line 59 through col. 7 line 10) such that it would have been obvious to recognize that the equipment is either outdoor or indoor equipment.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 32, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 41, Want discloses a method for providing information related to an inaccessible location to the inaccessible location, wherein the inaccessible location is at least one selected from the group consisting of a dedication site, an equipment site (col. 6 line 59 through col. 7 line 10) comprising storing the information on a permanently spatially fixed electronic tag (i.e., memory device) in a format that can be retrieved from the memory device and displayed to a user using a portable memory reading device (120, figure 2) separate from the memory device, upon request of the user on the portable memory reading device (col. 4 lines 29-67 and col. 8 lines 20-65) while in proximity to the memory device (figure 2 and col. 2 lines 21-27, col. 10 line 60 through col. 11 line 3 and col. 11 line 63 through col. 12 line 15), and substantially immovably affixing the memory device at wall and ceiling, i.e., the inaccessible location (col. 6



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line 59 through col. 7 line 10). The difference between Want and the claims is the claims specifically recite the inaccessible location group consisting of a cemetery site and a historically notable site. However, having the cemetery and historically notable site in the inaccessible location group do not have a disclosed purpose nor is these sites disclosed to overcome any deficiencies in the prior art. As such, the site may have been of any different site of the inaccessible location. In addition, Want teaches the electronic tag can be attached permanently or temporarily to various objects (col. 6 lines 59-61). Thus, it would have been an obvious matter of design choice to apply the method of Want in different inaccessible locations, such as a cemetery site or a historically notable site because it makes compatibility so that the method can be applied in different inaccessible locations.

Regarding claim 42, Want discloses a method comprising the additional step of replicating the information stored on the memory device in a database (col. 4 lines 17-20).

Regarding claim 43, Want discloses a method comprising the additional step of revising the replicated information at the database, and communicating the revised replicated information to the memory device over a communicable connection between the database and the memory device (col. 8 lines 56-57 and col. 9 lines 1-21).

Regarding claim 44, Want discloses a method comprising the additional step of providing the replicated information over a communication medium upon receipt by the database of an identifying code, the identifying code being uniquely associated with the memory device having the information stored thereon (col. 9 lines 22- 49).

Regarding claims 45-48, the difference between Want and the claims is the claims specifically recite the information comprises memorial information, historical information, the

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information of reasons for the dedication and selected user's manual, operation instruction and warranties. However, having these information do not have a disclosed purpose nor is these information disclosed to overcome any deficiencies in the prior art. As such, the data in the memory device may contain any type of information based on the object which the memory device attached with. In addition, Want teaches the data (i.e., information) contains in the electronic tag (i.e., memory device) are suitable to any related object's association data (col. 7 lines 38-48, col. 9 lines 22-44 and col. 10 lines 17-35). Thus it would have been an obvious matter of design choice to utilize the information comprising memorial information on the cemetery site, historical information on the historically notable site, reasons for the dedication on the dedication site and at least one selected from the group consisting of a user's manual, operation instructions and warranties on the equipment site as Want applied in different applications.

### ***Response to Arguments***

8. Applicant's arguments filed on May 27, 2003 (Paper no. 9) have been fully considered but they are not persuasive.

In response to applicant's argument that Want fails to disclose a system for providing instructions for substantially immovable equipment at an inaccessible location, and which including a permanently spatially fixed memory device affixed to the equipment, it appears that Want clearly discloses the electronic tags, i.e., memory device which have a semiconductor memory for data storage, processing logic and the electronic tags can include read only memory, EPROM and EEPROM or even flash memory (col. 1 lines 22-36), and the electronic tags can be

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permanently attached by embedment in various objects. Note while Want also teaches the various objects are including walls, floors, ceilings which are one kind of substantially immovable equipments (col. 6 line 59 through col. 7 line 10), which indicated on the above rejection as well. Thus, the claim does not clearly defined how the equipment is constructed with an object in order to achieve the substantially immovable results. Thus, this is enough to meet the unduly broad claims.

In response to applicant's argument that Want's electronic tag reader is not portable, it appears that Want clearly discloses the tag reading system (100, figure 2) is a hand holdable pen computer, i.e., handheld portable device, and an electronic tag reader (120, figure 2) can be easily concealed attached on the back of the handheld portable device with only minor modifications to the computer's housing (col. 10 line 60 through col. 11 line 3 and col. 11 line 63 through col. 12 line 15). Therefore, the claimed limitations are met by Want.

In response to applicant's argument that Want fails to teach any dedication information to a user and communications with the memory device and receiving the information for display upon request of the user on the portable memory reading device, it appears that Want clearly discloses a user movable shield permits use of the electronic tag as a user defined communication channel for transmitting small amounts of information as user desired (col. 4 lines 29-67). In addition, Want also teaches electronic tag reader is able to comprising a conventional passive or active matrix liquid crystal display for supplying information to different suitable user, which the tag reader can able to write as well as read electronic tag data (col. 8 lines 20-65). Therefore, the claimed limitations are met by Want.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 746-7239

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Fourth Floor (Receptionist).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zhuo H. Li whose telephone number is 703-305-3846. The examiner can normally be reached on Tuesday to Friday from 9:30 a.m. to 7:00 p.m. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached on (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Zhuo H. Li

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MATTHEW KIM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100